

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOROTHY L. ROERDEN and R. KEITH FRANK

Appeal No. 1996-1658
Application No. 07/792,553¹

ON BRIEF

Before CAROFF, GARRIS, and ROBINSON, Administrative Patent Judges.

CAROFF, Administrative Patent Judge.

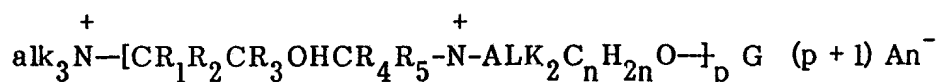
DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-17 and 34-48, all of the pending claims in the involved application.

¹ Application for patent filed November 15, 1991.

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1. A compound of the formula



wherein each alk is independently alkyl of 1-8 carbon atoms; each of R_1 , R_2 , R_3 , R_4 and R_5 is independently H or alkyl of 1-8 carbon atoms; each ALK is independently alkyl of 1-8 carbon atoms; n is 2-5; G is H, $\text{CR}_1\text{R}_2\text{CR}_3\text{OHCR}_4\text{R}_5\text{X}$ or $\text{CR}_1\text{R}_2\text{CR}_3\text{CR}_4\text{R}_5\text{O}$; X is Cl, Br or I; p is 1-10 and An^- is an anion; provided that the compound is soluble in water.

The claimed invention relates to a cationic compound having a single primary hydroxyalkyl moiety and certain derivatives thereof. Claim 1, the sole independent claim, is illustrative:

All of the claims on appeal stand rejected for obviousness under 35 USC § 103 over the following single prior art reference:

Login

4,812,263

March 14, 1989

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Based upon the record before us, we agree with appellants that the examiner has failed to present a prima facie case of obviousness. Accordingly, we are compelled to reverse the rejection at issue.

The Login reference does disclose bis-quaternary ammonium compounds which generically encompass compounds defined by the instant claims wherein "G" is hydrogen and "p" is 1. However, as indicated by appellants in their brief, there appears to be nothing in Login which would provide a person of ordinary skill in the art with the requisite motivation to select an asymmetric compound having a single primary hydroxyalkyl moiety from the myriad of possible compounds covered by Login's generic formula. Appellants' specification (p.1, lines 10-23) suggests using the claimed cationic monoprimary alcohol in preparing a cationic starch in order to avoid undesired cross-linking. In contrast, Login does not even address this cross-linking problem, let alone suggest that one should select a monoprimary alcohol grouping, in particular, for this or any other purpose.

The fact that a claimed compound or subgenus may be encompassed by a generic formula disclosed in the prior art

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does not by itself render that compound or subgenus obvious. Factors which militate against a finding of obviousness here are elucidated in the line of cases represented by In re Baird, 16 F.3d 380, 382, 29 USPQ 2d 1550, 1552 (Fed. Cir. 1994). As in Baird, we are confronted with a prior art generic formula encompassing a vast number of potential bis-quaternary ammonium compounds.

Also, the subgenus defined by appellants' claims is of substantially narrower scope.

Additionally, as we have previously noted, appellants have disclosed that their monopropyl alcohols are particularly suited for preparing cationic starch while avoiding the problem of undesirable cross-linking, a problem encountered in the prior art but not addressed by Login.

Although we do not agree with appellants that Login expresses a preference for symmetrical compounds or for substituents of more than 12 carbon atoms, this in no way alters our conclusion that the examiner has failed to establish a prima facie case of obviousness. It is the examiner, after all, who has the initial burden of

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establishing a prima facie case which, in our opinion, the
examiner has not done.

For the foregoing reasons, the decision of the examiner
is reversed.

REVERSED

MARC L. CAROFF)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
DOUGLAS W. ROBINSON)	
Administrative Patent Judge)	

lp

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Application No. 07/792,553

APJ CAROFF

APJ ROBINSON

APJ GARRIS

DECISION: REVERSED

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s): _____

Prepared: January 31, 2001

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT